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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,679	04/11/2001	RACHEL BAR-SHAVIT	108366	3009

7590 09/05/2002
Oliff & Berridge
PO Box 19928
Alexandria, VA 22320

EXAMINER

LACOURCIERE, KAREN A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 09/05/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/744,679		BAR-SHAVIT, RACHEL	
	Examiner		Art Unit	
	Karen Lacourciere		1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2, 4-6, 9-12 and 14-19, drawn to an antisense molecule targeted to an RNA encoding a thrombin receptor and methods of treatment using the antisense, classified in class 536, subclass 24.5.
- II. Claims 1, 3-5, 9-15 and 17-19, drawn to an antisense molecule targeted to an RNA encoding a protease activated receptor-2 (PAR-2) protein and methods of treatment using the antisense, classified in class 536, subclass 24.5.
- III. Claims 1, 3-5, 9-15 and 17-19, drawn to an antisense molecule targeted to an RNA encoding a protease activated receptor-3 (PAR-3) protein and methods of treatment using the antisense, classified in class 536, subclass 24.5.
- IV. Claims 1, 3-5, 9-15 and 17-19, drawn to an antisense molecule targeted to an RNA encoding a protease activated receptor-4 (PAR-4) protein and methods of treatment using the antisense, classified in class 536, subclass 24.5.
- V. Claims 7 and 8, drawn to a method of treating metastatic cancer using an antibody targeted to a PAR protein, classified in class 514, subclass 2.

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The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not capable of use together and have different modes of operation. For example, the antisense of Group I function by binding an mRNA encoding a thrombin receptor and inhibiting the expression of a thrombin receptor protein, whereas the antisense of Group II function by binding to an mRNA encoding PAR-2 and inhibiting the expression of PAR-2. The antisense of each Group would differ materially, in that the structure of each antisense (ie. sequence) would differ and further, the antisense of each Group would function to inhibit a different biological target.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not capable of use together and have different modes of operation. For example, the antisense of Group I function by binding an mRNA encoding a thrombin receptor and inhibiting the expression of a thrombin receptor protein, whereas the antisense of Group III function by binding to an mRNA encoding PAR-3 and inhibiting the expression of PAR-3. The antisense of each Group would differ materially, in that the structure of each antisense (ie. sequence) would differ

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and further, the antisense of each Group would function to inhibit a different biological target.

Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not capable of use together and have different modes of operation. For example, the antisense of Group II function by binding an mRNA encoding a thrombin receptor and inhibiting the expression of a thrombin receptor protein, whereas the antisense of Group IV function by binding to an mRNA encoding PAR-4 and inhibiting the expression of PAR-4. The antisense of each Group would differ materially, in that the structure of each antisense (ie. sequence) would differ and further, the antisense of each Group would function to inhibit a different biological target.

Inventions I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to materially different inventions which are not capable of use together and have different modes of operation. For example, the antisense molecules of Group I are composed of nucleotides and operate by binding to an mRNA encoding a thrombin receptor to inhibit the expression of a thrombin receptor protein, which is different than the antibodies used in the methods of

treatment of Group V, which are composed of amino acids and function by binding to a PAR protein and inhibiting the function of the protein.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not capable of use together and have different modes of operation. For example, the antisense of Group II function by binding an mRNA encoding PAR-2 and inhibiting the expression of PAR-2, whereas the antisense of Group III function by binding to an mRNA encoding PAR-3 and inhibiting the expression of PAR-3. The antisense of each Group would differ materially, in that the structure of each antisense (ie. sequence) would differ and further, the antisense of each Group would function to inhibit a different biological target.

Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not capable of use together and have different modes of operation. For example, the antisense of Group II function by binding an mRNA encoding PAR-2 and inhibiting the expression of PAR-2, whereas the antisense of Group IV function by binding to an mRNA encoding PAR-4 and inhibiting the expression of PAR-4. The antisense of each Group would differ materially, in that the structure of each antisense (ie. sequence) would differ and further, the antisense of each Group would function to inhibit a different biological target.

Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to materially different inventions which are not capable of use together and have different modes of operation. For example, the antisense molecules of Group II are composed of nucleotides and operate by binding to an mRNA encoding PAR-2 to inhibit the expression of PAR-2 protein, which is different than the antibodies used in the methods of treatment of Group V, which are composed of amino acids and function by binding to a PAR protein and inhibiting the function of the protein.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not capable of use together and have different modes of operation. For example, the antisense of Group III function by binding an mRNA encoding PAR-3 and inhibiting the expression of PAR-3, whereas the antisense of Group IV function by binding to an mRNA encoding PAR-4 and inhibiting the expression of PAR-4. The antisense of each Group would differ materially, in that the structure of each antisense (ie. sequence) would differ and further, the antisense of each Group would function to inhibit a different biological target.

Inventions III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

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operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to materially different inventions that are not capable of use together and have different modes of operation. For example, the antisense molecules of Group III are composed of nucleotides and operate by binding to an mRNA encoding PAR-3 to inhibit the expression of PAR-3 protein, which is different than the antibodies used in the methods of treatment of Group V, which are composed of amino acids and function by binding to a PAR protein and inhibiting the function of the protein.

Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to materially different inventions that are not capable of use together and have different modes of operation. For example, the antisense molecules of Group IV are composed of nucleotides and operate by binding to an mRNA encoding PAR-4 to inhibit the expression PAR-4 protein, which is different than the antibodies used in the methods of treatment of Group II, which are composed of amino acids and function by binding to a PAR protein and inhibiting the function of the protein.

Claims 1, 4, 5, 9-11, 14, 15 and 17-19 are generic to Group I-IV and claims 3 and 13 are generic to Groups II-IV. Upon election of any of Groups I-IV, these claims will only be examined to the extent that they read on the elected invention.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Margaret Mealy on 08-02-2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A. Lacourciere whose telephone number is (703) 308-7523. The examiner can normally be reached on Monday-Friday 8:30-4:30.

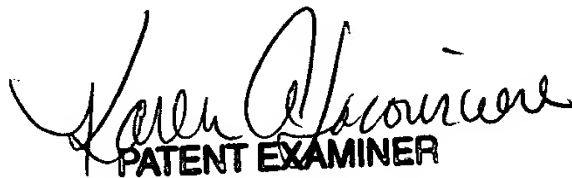
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703) 308-0447. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-1935 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Karen A. Lacourciere
September 3, 2002



PATENT EXAMINER